

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

JUNE 9, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Blue Cross and Blue Shield of Minnesota

v.

Rx Aware, Inc.

Opposition No. 97,936
to application Serial No. 74/476,685
filed on January 5, 1994

J. Randall Benham of Oppenheimer Wolff & Donnelly for Blue
Cross and Blue Shield of Minnesota

James N. Hulme of Kelly & Hulme for Rx Aware, Inc.

Before Seeherman, Quinn and Hohein, Administrative Trademark
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Blue Cross and Blue Shield of Minnesota has opposed the
application of Rx Aware, Inc. to register RxAWARE and
design, with Rx disclaimed, for "consulting services in the
field of drug interactions."¹ The mark is shown below.

¹ Application Serial No. 74/476,685, filed January 5, 1994,
asserting first use and first use in commerce in May, 1991.

As grounds for opposition opposer has alleged that it provides services in the field of health and health insurance; that it has made prior use of the marks AWARE and AWARE GOLD for its products and services; that it owns registrations for these marks; and that applicant's use of its mark on its identified services is likely to cause confusion. In its answer applicant has denied the allegations of the notice of opposition.²

The record includes the pleadings; the file of the opposed application; applicant's responses to opposer's first set of interrogatories; opposer's registrations for AWARE³ and AWARE GOLD⁴ for, in each instance, "health insurance underwriting services and administering insurance plans for others" and "arranging health care services for others"; the affidavits of William Jenison, Jack Yarbrough, Mary Stevens, Richard Wagenman, Petrice Balkan-Feick, Roger R. Greenwald, Ray Kuntz, William J. Riley, Larry G. Solberg

² Applicant also asserted as a pro forma affirmative defense that opposer failed to allege grounds sufficient to establish its standing. Applicant never filed a motion to dismiss, nor did it pursue an allegation that opposer failed to prove its standing. Accordingly, this "defense" is deemed to have been waived.

³ Registration No. 1,348,499, issued July 9, 1985; Section 8 affidavit accepted; Section 15 affidavit filed.

⁴ Registration No. 1,361,020, issued September 17, 1985; Section 8 affidavit accepted; Section 15 affidavit received.

and David Lamson; and a search report prepared by a private company.⁵

The case has been fully briefed, but an oral hearing was not requested.

Opposer is a wholly-owned subsidiary of Aware Integrated, Inc. It has previously been the parent corporation of various companies which are currently subsidiaries of Aware Integrated, but in July 1994 a corporate restructuring occurred and Aware Integrated was formed as the holding corporation. Each of its subsidiaries provides a service or product complementary to the integrated health care system of Aware Integrated.

Opposer is "Minnesota's first and largest health coverage carrier." Jenison, ¶ 3. It markets health care management and financing services to Minnesota customers and, through subsidiaries, to customers nationwide. Through its various subsidiaries, as well as through partnerships

⁵ Both opposer and applicant submitted all of this evidence under a notice of reliance. While the interrogatories and responses thereto may be made of record pursuant to a notice of reliance, the plain copies opposer submitted of its pleaded registrations do not meet the requirements of Trademark Rule 2.122(d)(2), which provides that a party may make its own registration(s) of record by submitting status and title copies thereof. Similarly, the search report prepared by a private company, submitted by applicant, does not constitute an official record or a printed publication within the contemplation of Trademark Rule 2.122(e). Moreover, while Trademark Rule 2.123(b) provides that, by agreement of the parties, the testimony of any witness may be submitted in the form of an affidavit, in this case the parties did not submit such an agreement. However, both opposer and applicant have treated all of the submissions as

formed with hospitals, clinics and health care providers, opposer provides an array of health care-related products and services.

Since the mid 1980's opposer has used the marks AWARE GOLD, AWARE CARE⁶ and AWARE in connection with its health care-related products and services. Opposer markets to subscribers two health care plans under the marks AWARE GOLD and AWARE CARE. The AWARE CARE plan is offered by opposer to individuals who are not covered by a group health plan.

The AWARE GOLD health plan was introduced over ten years ago, and is opposer's most popular. Opposer has established a network of AWARE GOLD health care providers which includes thousands of physicians, hospitals and clinics. This AWARE network encompasses every hospital and virtually every physician (16,500) in the state of Minnesota. The AWARE GOLD providers receive literature about the AWARE GOLD health plans, sign AWARE provider service agreements with opposer and have recognition in the industry as AWARE providers.

Both of the AWARE health plans are marketed primarily to employers located within Minnesota. However, opposer's

being of record, and we therefore deem them to have been stipulated into the record.

⁶ Although opposer did not plead ownership of common law rights in this mark, we deem the pleadings to have been amended pursuant to Fed. R. Civ. P. Rule 15(b) to assert a claim based on this mark. We would also point out that, even without this mark, our decision herein would be the same.

affiliated companies market these health plans to employers located in bordering counties in four states, and opposer also provides the control health plan for a number of large national employers which have employees located throughout the United States, so that thousands of employees nationwide are covered under opposer's AWARE GOLD health plans. These employees are provided with AWARE GOLD membership information and AWARE GOLD coverage cards.

Health care providers in Minnesota often refer to a particular health plan or provider network of opposer as the "Aware" plan or the "Aware" network, and many providers refer to themselves as "Aware" providers. The AWARE GOLD network typically refers to the network of physicians and the AWARE network typically refers to the network of hospitals. Employers, their health benefit managers, and their covered employees commonly refer to their coverage or health plan simply as "Aware."

Opposer spends over \$3.5 million each year advertising its various products and services, which include its AWARE products and services. In 1994, opposer generated revenues of over \$1.25 billion, "a recognizable portion of which could be allocated to revenues received from Aware Gold® or Aware Care™ health plans." Jenison, ¶ 11.⁷

⁷ Opposer has not provided specific information as to the sums spent or revenue generated in connection with the AWARE marks.

Aware Integrated Systems operates as a business line of opposer's. This is the primary information management and technology resource for the integrated health care system of Aware Integrated, Inc., opposer's parent company. Aware Integrated Systems has a network of computer software systems which, inter alia, provide information processing and decision making functions related to health care provider information, health plan enrollment and eligibility, and claims management. These information services are being marketed to other health plan organizations.

Opposer's parent company had also, at the time Mr. Jenison's affidavit was signed on June 20, 1996, recently "made a decision to form a new limited liability company which will be called 'Aware Dental Services'." This company was to provide dental claims administration and various dental products and services to other health plan organizations. According to Mr. Jenison, "under current plans, Aware Dental Services will become a viable business operation in July of 1996." ¶8.

Pharmacy Gold, Inc. had been incorporated as a subsidiary of opposer in 1993, but because of the restructuring mentioned above, it and opposer are now wholly-owned subsidiaries of Aware Integrated, Inc.

Pharmacy Gold is a pharmacy benefit management company which provides prescription drug and pharmaceutical management services to clients throughout the country. One of its services is drug utilization review, which is a review of prescription drug compatibility and usage issues. Pharmacy Gold markets its services primarily to large employers, other pharmacy benefit management companies, and various health plans. Although it does not market its services directly to health care providers, it has frequent interaction with health care providers as a result of its drug utilization review services, pharmacist networks, and its health care provider educational programs.

We have relatively little information about applicant because the affidavit of David Lamson, its president, which was the only testimony submitted, consists primarily of argument. The affidavit does state, however, that applicant was formed in 1993 to develop software and related services for use by medical professionals to provide comprehensive drug interaction information. Applicant chose its mark to indicate that its service was to make the public at large and medical professionals in particular aware of possible drug interactions.

Further, applicant's responses to opposer's interrogatories, made of record by opposer, state that the goods or services applicant sells or intends to sell under

the mark RxAWARE are "software programs, including associated databases, for use by health care professionals, which allow users to maintain accurate patient medical records, receive appropriate drug therapies, analyze possible drug interaction, determine proper drug change and the like," (response to Int. No. 2), and a drug interaction reporting service using this software. The interaction service and software was tested among friends and relatives, and was distributed in Long Island, New York, for a period of eight months to one year. The interaction report service test was not successful and produced no sales; the software program is still being developed.

Advertising has been limited to press releases distributed throughout the New York tri-state area to newspapers with a circulation of 5,000 or more.

Mr. Lamson acknowledged, in his affidavit, that "Opposer provides services in association with trademarks containing the word 'Aware' alone and with some type of suffix as a part of the mark (i.e.,: Gold, Care and the like)" ¶ 8; that "these marks are used in association with various health care plans and services including providing health care provider's [sic] with information concerning health care plan enrollment and eligibility and health care claims management" ¶ 9; and "conceded that Opposer and it's [sic] Aware® family of marks are well known in their field"

¶ 14,⁸ although Mr. Lamson pointed out that this field is the area of health insurance and insurance administration services and plans and not the area of consulting services in the field of drug interactions.

Priority is not in issue in view of opposer's pleaded registrations. **King Candy Co. v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the record established opposer's earlier use of the marks AWARE, AWARE GOLD and AWARE CARE in connection with its health care plans.

Turning to the issue of likelihood of confusion, we have considered all of the relevant du Pont factors, **In re E. I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), in determining that applicant's use of RxAWARE for consulting services in the field of drug interactions is likely to cause confusion with opposer's use of AWARE, AWARE CARE and AWARE GOLD for arranging health care services for others and offering health care plans.

First, the marks of the parties are very similar. Applicant's mark, because it is depicted with the "x" as a subscript, emphasizes the word AWARE which, because of the descriptive significance of Rx, must be considered the

⁸ We note that opposer neither pleaded nor submitted evidence that it had an AWARE family of marks. Accordingly, although applicant has referred in both Mr. Lamson's testimony and in its brief to such a family, this "concession" has played no part in our decision herein.

dominant part of the mark. Opposer not only has registrations for the marks AWARE GOLD and AWARE for, inter alia, arranging health care services for others, but the evidence shows that one of its health plans is marketed as the AWARE CARE plan, while the providers of opposer's health care plans are referred to as AWARE providers. As a result of opposer's use of these various AWARE marks in connection with health care plans and for arranging health care services, consumers are very likely to view the mark RxAWARE as one of opposer's AWARE marks. This is not to say that they will ignore the Rx which forms the initial element of applicant's mark, or even that they will not recognize that the connotation of RxAWARE for the identified services suggests a concern about drug interactions. However, consumers seeing RxAWARE in connection with "consulting services in the field of drug interactions" are likely to believe that RxAWARE is a variant of opposer's other AWARE marks, chosen to indicate the specific services with which it is used, rather than as a mark indicating origin in a separate source.

As for the respective services, although we cannot accept opposer's argument that the services identified in opposer's registrations--arranging health care services for others--would encompass "consulting services in the field of

drug interactions," we do find that the services are related and could be expected to emanate from a single source.

Opposer has shown that one of its former subsidiaries, and now its sister company, provides a service similar to that identified in applicant's application, namely the review of prescription drug compatibility and usage issues. Although this service is rendered under the trade name Pharmacy Gold, Inc., the activities of this company show that drug utilization review services may be rendered through the same organization which arranges health care services. Moreover, the record shows that opposer's parent, Aware Integrated, Inc. is engaged, through its various subsidiaries, in a wide range of health related services, many of which are rendered under "Aware" trade names. Thus, consumers and health care providers who are familiar with opposer's activities in the health care field are likely, upon seeing RxAWARE used in connection with consulting services in the filed of drug interactions, to believe that such services emanate from opposer or one of its related companies. See **In re International Telephone & Telegraph Corp.**, 197 USPQ 910, 911 (TTAB 1978) ("It is not necessary that the goods of the parties be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are

related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer.")

Another factor in our finding of likelihood of confusion is the fame of opposer's AWARE marks. We find that opposer's AWARE GOLD and AWARE marks are famous at least in the state of Minnesota, where 98% of the physicians, and 100% of the hospitals, participate in the AWARE GOLD plan, and are part of the AWARE network.⁹ See **Giant Food, Inc. v. Nation's Foodservice, Inc.**, 218 USPQ 390, 394 (Fed. Cir. 1983); **Carl Karcher Enterprises Inc. v. Stars Restaurant Corp.**, 35 USPQ2d 1125, 1130 (TTAB 1995). The fame of a mark "plays a dominant role in cases featuring a famous or strong mark." See **Kenner Parker Toys Inc. v. Rose Art Industries, Inc.**, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Certainly the hospitals, doctors,

⁹ The search report showing third-party registrations for marks containing the term AWARE do not detract from our finding that opposer's marks are strong. There are only two such registrations, for PROJECT HEALTH AWARE for promoting public awareness of health topics, fitness and the importance of health-related organizations and ARTHRITIS AWARENESS CENTER for medical services, namely, operating a medical center specializing in the treatment of patients afflicted with arthritis. Suffice it to say that these registrations do not show that AWARE, as used for opposer's services, has a suggestive meaning, or that opposer's marks are weak.

pharmacies and consumers in Minnesota are likely, because of the strength of opposer's various AWARE marks, to assume that there is an association of source between RxAWARE for drug interaction consulting services and opposer.

Although this point has not been argued by applicant, we have also considered the du Pont factor of the conditions under which and buyers to whom sales are made. Hospitals, doctors and pharmacies must be considered sophisticated purchasers, while individuals who would be interested in consulting services in the field of drug interactions would presumably be careful purchasers. Nevertheless, because of the strength of opposer's marks, the similarity of the marks and the relatedness of the services, we find that even careful purchasers are likely to be confused by applicant's use of RxAWARE for its services.

Finally, any doubts about likelihood of confusion must be resolved against applicant as the newcomer. **Century 21 Real Estate Corporation v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992); **In re Hyper Shoppes (Ohio)**, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir.

Decision: The opposition is sustained, and registration to applicant is refused.

E. J. Seeherman

T. J. Quinn

G. D. Hohein
Administrative Trademark Judges
Trademark Trial and Appeal Board